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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,285	12/18/2000	Masaaki Nishikiori	1086.1128/JDH	2128
21171	7590	04/18/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CHARLES, DEBRA F	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/738,285	NISHIKIORI ET AL. ✓
	<b>Examiner</b>	<b>Art Unit</b>
	Debra F. Charles	3624

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 February 2005.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

***Response to Amendment***

1. Claims 1, 2, 5, 6, 7, 8, 9, 11, 13, and 14 have been amended. Claim 15 has been added. Rejection 112, 2<sup>nd</sup> has been revoked based on the attorney's changes to the claims.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.
3. Since there is no definition of "mediating", "service" or "units" in the specification that especially defines the meets and bounds for these two terms, the examiner is using the broadest definition for these terms.
4. The claims are too broad and they do not specifically define the invention tightly around the apparatus. Further, fuzzy logic and expert systems when used in decisionmaking are old and well-known technologies. However, claim 14 is being interpreted as being statuary because the preamble indicates computer program.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the bodies of the claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) The claimed invention must produce a “useful, concrete, tangible result” ( *In re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street vs. Financial Signature Group Inc.*, 47 USPQ2d 1596’ 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP 2106 IV B 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In *State Street*, “in the technological arts” was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgida et al.(U.S.PAT. 5418943 A) and Corey et al.(U.S.PAT. 5987446 A).

Re claim 1: Borgida disclose an information mediating apparatus for providing mediation services for the user(Abstract), comprising:  
a mediating condition storing unit in which mediating condition list data describing specific mediating conditions necessary for mediation has been stored(claim 1, i.e. a database is a storage unit); and  
a mediation service processing unit which reads out the mediating condition list data designated in correspondence to a user request from said mediating condition storing unit, (claims 1-13, col. 3, lines 50-60, col. 4, lines 15-55, col. 6, lines 15-67, col. 7, line 35-col. 8, line 65, col. 9, lines 15-65).

Borgida et al. disclose(s) the claimed invention except obtains specific conditions in said read-out mediating condition list data, another information storing unit merges said specific conditions, searches information which satisfies said merged conditions, and presents said

information to the user. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claim 2: Borgida et al. disclose(s) the claimed invention except a user interface processing unit which forms display information such as mediation menu, mediation result, and the like and presents said display information to the user; and a logic processing unit which reads out said mediating condition list data, notifies a service providing server group of said read-out data, and forms mediation result information by matching with service information. However, in col. 6, line 35-col. 7, line 35, thereof, Corey et al. disclose(s) a display manager that coordinates a display of data aligned to show the matching result. It would be obvious to one of ordinary skill in the

art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is to show the combined results on the display for the user.

Re claim 3: Borgida et al. disclose said mediation service processing unit designates and reads out specific mediating condition list data by analyzing an uncertain, rough, and abstract request from the user(col. 7, line 35-col. 9, line 65).

Re claim 4: Borgida et al. disclose(s) the claimed invention except said mediation service processing unit presents a selection menu in which request contents are divided into items to the user and designates and reads out the specific mediating condition list data in correspondence to selected menu items. However, in col. 6, line 35-col. 7, line 35, thereof, Corey et al. disclose(s) a display manager that coordinates a display of data aligned to show the matching result. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is to

show the combined results on the display for the user formatted in a way the user prefers.

Re claim 5: Borgida et al. disclose(s) the claimed invention except said mediation service processing unit extracts corresponding personal information and merges with reference to a personal information storing unit. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claims 6 and 7: Borgida et al. disclose in the case where the corresponding personal information does not exist or does exist, said

mediation service processing unit requests the user to input the personal information(col. 4, lines 55-65, claims 14, 15, and 17).

Re claim 8: Borgida et al. disclose wherein in the case where inquiring conditions to the user exist in the read-out mediating condition list data, said mediation service processing unit merges corresponding personal information as default values by referring to a personal information storing unit and, thereafter, requests the user to input the personal information while presenting said default values(col. 4, lines 55-65, claims 14, 15, and 17).

Re claim 9: Borgida et al. disclose(s) the claimed invention except in the case where calculating conditions exist in the read-out mediating condition list data, said mediation service processing unit executes a predetermined calculating expression on the basis of other mediating conditions and merges a result of said calculation. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to

one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claim 10: Borgida et al. disclose wherein said mediation service processing unit executes a predetermined calculating expression on the basis of conditions merged by referring to a personal information storing unit or by inquiring of the user and merges a result of said calculation into said calculating conditions(col. 3, lines 50-65, col. 4, lines 55-67, col. 9, line 65-col. 12, line 15) .

Re claim 11: Borgida et al. disclose in the case where the mediating condition list data read out from said mediating condition storing unit has a layer structure, said mediation service processing unit obtains necessary conditions by sequentially referring to the personal information storing unit from a predetermined layer, by inquiring of the user, and/or by performing a

calculating process and merges them(col. 3, lines 50-65, col. 4, lines 55-67, col. 9, line 65-col. 12, line 15).

Re claim 12: Borgida et al. disclose(s) the claimed invention except mediation service processing unit forms new mediating condition list data on the basis of a mediation result presented to the user and decided and stores it into said mediating condition storing unit. However, in col. 6, lines 35-65, Fig. 6C, thereof, Corey et al. disclose(s) combining two separate outputs into one output. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claims 13 and 14: Borgida disclose an information mediating method of providing mediation services for the user(Abstract), comprising the steps of:

storing mediating condition list data describing specific mediating conditions necessary for mediation into a mediating condition storing unit(claim 1, i.e. a database is a storage unit, col. 3, lines 50-60, col. 4, lines 15-55, col. 6, lines 15-67, col. 7, line 35-col. 8, line 65, col. 9, lines 15-65).

Borgida et al. disclose(s) the claimed invention except reading out the mediating condition list data designated in correspondence to a user request from said mediating condition storing unit; obtaining specific conditions mediating condition list data by referring to another in said read-out information storing unit, by inquiring of the user, *and/or* by performing a calculating process based on predetermined conditions and merging said specific conditions; and

searching information which satisfies said merged conditions and presenting said information to the user. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

Re claim 15: Borgida disclose a method of providing intermediary services to a user(Abstract), comprising: storing a list of intermediary service information for each of the services the intermediary service information list

(claim 1, i.e. a database is a storage unit) comprising fixed service information and a variable information source(claims 1-13, col. 3, lines 50-60, col. 4, lines 15-55, col. 6, lines 15-67, col. 7, line 35-col. 8, line 65, col. 9, lines 15-65);

Borgida et al. disclose(s) the claimed invention except receiving a service request from a user and identifying a service on the list; obtaining variable service information from the variable information source for the service of the request identified on the list; and merging the fixed service information and the variable service information and providing the intermediary service of the service request to the user responsive to the merged information. However, in col. 2, lines 10-col. 3, line 35, col. 6, lines 25-65 thereof, Corey et al. disclose(s) two different query search engines that effectively create two different storage units, and combines the query conditions into one set of results. It would be obvious to one of ordinary skill in the art to modify the invention of Borgida et al. based on the teachings of Corey et al. The motivation to combine these references is this type of search engine offers a significant advantage in that typically, the expressions input by a user are simple lists of words or phrases and are of benefit to unsophisticated users.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone

number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles  
Examiner  
Art Unit 3624

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VINCENT A. MILLIN  
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